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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/666,301

09/21/2000

Robert J. Martin

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03/29/2004

BURNS DOANE SWECKER & MATHIS L L P  
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EXAMINER

MORAN, TIMOTHY J

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 0304

Application Number: 09/666,301  
Filing Date: September 21, 2000  
Appellant(s): MARTIN, ROBERT J.

M. David Ream  
For Appellant

**MAILED**

**MAR 29 2004**

**GROUP 2800**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 5, 2004.

Art Unit: 2878

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed after the most recent final amendment, filed September 5, 2003.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

The appellant's statement of the issues in the brief is substantially correct.

The changes are as follows: After further consideration, the rejections under 35 U.S.C. 103 are withdrawn.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 7 and 9, and claim 10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 7, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 7 and 9, the original specification does not teach a method of switching a charge well based on a rate at which moving charges fill a

charge well, specifically a method of determining said rate, and a method of determining the proper time for switching.

Regarding claim 10, the original specification does not teach a method of varying an integration capacitance based on a rate at which moving charges fill a charge well, specifically a method of determining said rate, and a method of determining the proper capacitance variation.

**(11) Response to Argument**

In response to appellant's argument (page 3, last paragraph and page 4, first paragraph) that the originally filed application teaches switching "based on a rate at which the moving charges fill the first charge well," it is noted that a method of detecting a rate of moving charges is not described in the originally filed application. While it is acknowledged that the specification describes the process of target electrons filling the charge well, this is considered to be different from teaching that the filling rate of the electrons is to be detected and used to determine switching actions. Therefore it is considered that the present claims are not enabled under 35 U.S.C 112.

In response to appellant's argument (page 4, second and third paragraphs) that a person of ordinary skill in the art would have been able to make and use the claimed invention, it is acknowledged that the specification teaches the changing of the charge well capacitance depending on whether the detector is detecting "faint" targets or "hot" targets (see original specification, page 9, lines 19-28). However, it is considered that the specification does not provide sufficient guidance concerning the method of determining when the

capacitance changing actions should take place. Since the art of varying capacitances is a large one, it is considered that undue experimentation would be required for one of ordinary skill in the art, in possession of the original specification, to arrive at the specific decision method of the present claims (detecting a charge well filling rate). See MPEP 2164.01. Therefore it is considered that the present claims are not enabled under 35 U.S.C. 112.

In response to appellant's argument (page 5, first paragraph) that experimentation required to arrive at the present claims is predictable and commonly performed, it is noted that the applicant has not provided evidence that such experimentation is likely to result in the specific decision method of the present claims (detecting a charge well filling rate). Therefore it is considered that the present claims are not enabled under 35 U.S.C. 112.

In response to appellant's argument (page 5, second paragraph) that the present application implicitly discloses using sensor signals to control capacitance values, it is noted that a method of detecting a rate of moving charges is not described in the originally filed application. Therefore it is considered that the present claims are not enabled under 35 U.S.C. 112.

In response to appellant's argument (page 5, last paragraph, and page 6, first paragraph) that a person of ordinary skill in the art would reasonably conclude that the inventor possessed the claimed invention, it is noted that the specific decision method of the present claims (detecting a charge well filling rate) is not described in the originally filed application. Therefore it is considered that the present claims are not enabled under 35 U.S.C. 112.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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March 16, 2004

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